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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,142	02/27/2004	Bruce Elliot Kramer	SOAP1	4632
7590 06/09/2009 BRUCE ELLIOT KRAMER 9112 CHERBOURG DR. POTOMAC, MD 20854				
EXAMINER				
OGDEN JR, NICHOLUS				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
06/09/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/787,142

**Applicant(s)**

KRAMER ET AL.

**Examiner**

Necholus Ogden, Jr.

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24, 26 and 29-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24, 26, 29-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 4-27-2009 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 24, 26, 29-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sonnenberg et al (6,673,756).

Sonnenberg et al disclose a multiphase soap comprising two or more phases wherein each phase may be opaque and/or comprise different color(s) or dye(s) (col. 21, lines 60-64; col. 26, lines 30-35 and claims 1-5). Sonnenberg et al further teach that said multiphase soap bar comprises an antibacterial components (col. 15, lines 14-42) and further teach that said bar comprises an object for advertising purposes such as a toy of gold or similar materials (col. 21, lines 50-col. 22, line 16).

Sonnenberg et al do not teach with sufficient specificity to anticipate the claims comprising each of the colors in specific layers.

It would have been obvious to one of ordinary skill in the art to disperse the various colors in a specific layers as claimed because Sonnenberg et al teach a multiphase soap bar having two or more phases in different colors (col. 26, lines 30-35). Moreover, one of ordinary skill would have been motivated to comprise a soap bar with a variety of colors for aesthetic reasons or for advertisement considerations. Accordingly, one of ordinary skill in the art would construe specific colors or layers as

matters relating to ornamentation or aesthetic design changes which have no mechanical function and therefore cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

### ***Response to Arguments***

5. Applicant's arguments filed 4-27-2009 have been fully considered but they are not persuasive.

Applicant argues that the inside layer of claimed invention **is not** visible from the outside since it now calls out an outside layer surrounds at least one inside layer and therefore distinguishes itself from the Sonnenberg et al reference.

The examiner contends that applicant's claims do not state that the inside layer is not visible, but that the outside layer is a different color than at least one inside layer (see claim 24). Therefore, the argument with respect to visibility is not well founded since one inside layer can be different but other inside layers may be the same as the outside layer. Moreover, applicant does not have support for his assertion of the visibility of the inside layer in his specification. Accordingly, the skilled artisan would have been able to arrange a variety of different colors of the soap bar of Sonnenberg et al for aesthetic or commercial purposes since Sonnenberg et al teach bars with a plurality of layers and colors (col. 26, lines 30-35).

Applicant argues that Sonnenberg et al do not teach or suggest a step of washing or bathing with a cleansing bar so that the outside, top or first layer(s) "disappear".

The examiner contends that this step would have been obvious to the skilled artisan since washing with a soap bar inherently removes the outer layer due to the friction of rubbing the soap bar on the user's skin or cloth, thereby dissolving or "disappearing" the outer or top layer.

Applicant argues that the soap bars of Sonnenberg et al do not motivate a child to wash and improve their hygiene by providing a bar with rainbow colors and a prize identifier such as a pot of gold as recited in claim 58.

The examiner contends and respectfully disagrees because the prior art of record, Sonnenberg et al teach bars with a variety of colors and layers and one skilled in the art would have been motivated to assemble the layers and colors as claimed for aesthetic or commercial purposes, absent a showing to the contrary. With respect to motivating a child to wash, the examiner contends that this would be an inherent property of the soap bars because as Sonnenberg et al teach layered soap bars with a plurality of colors in a variety of arrangements and formulated with surfactants, one skilled in the art would expect said soap bars to be used for the inherent purpose of motivating any human, and including a child, to wash or bathe with said bar. With respect to improving a child's hygiene, the examiner contends that the soap bars have cleansing phases, which would clean and improve the hygiene of a child if used as a cleansing personal soap bar as suggested by Sonnenberg et al. With respect to the prize identifier or pot of gold, Sonnenberg et al teach that said bar comprises an object for advertising purposes such as a toy of gold or similar materials (col. 21, lines 50-col. 22, and line 16). Accordingly, the courts held that reason or motivation to modify the

reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. In *re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) (*re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991)) "it is not necessary in order to establish a prima facie case of obviousness . . . that there be a suggestion or expectation from the prior art that the claimed [invention] will have the same or a similar utility as one newly discovered by applicant," and concluded that here a prima facie case was established because "[t]he art provided the motivation to make the claimed compositions in the expectation that they would have similar properties."

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Necholas Ogden, Jr. whose telephone number is 571-272-1322. The examiner can normally be reached on M-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Necholus Ogden, Jr./  
Primary Examiner  
Art Unit 1796

6-8-2009